

are incorporated herein by reference. The examiner's frankness in stating his position is appreciated, and this amendment is made in order to place the claims in better condition for appeal. Claims 18 and 20 were amended to match the terminology of claims 12 and 19 as now amended.

New claims 23-28 have been added to elaborate on specific kinds of miniature environments, since the examiner has expressed his view (with which applicants disagree) that this phrase reads on an undecorated windowless room. Claims 12 and 19 a "design" which by definition is not the absence of a design.

The examiner further states his belief specific designs or indicia cannot impart patentability. The examiner seems to be making a printed matter rejection. Combinations including both structural features and printed matter are patentable if the when the claim defines a new and useful relation between the printed matter and the physical structure. Limitations which relate to the printed matter are proper and cannot be disregarded when determining patentability.

The Federal Circuit made this clear in In re Gulack, 217 USPQ 401, 403 (Fed. Cir. 1983):

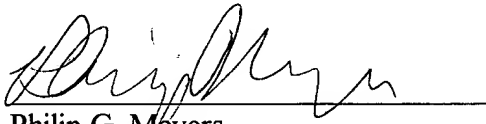
Differences between an invention and the prior art cited against cannot be ignored merely because those differences reside in the content of the printed matter. Under section 103, the Board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole.

The examiner does not appear to be considering the claimed invention as a whole, or giving the term "miniature environment" a reasonable interpretation in light of applicants' specification. In particular, the word "miniature" implies that whatever is shown in the panel designs is on a scale smaller than actual size, such as in a doll house. There is a functional relationship between the

design and the supporting structure; together they create the miniature environment. This relationship is neither anticipated by nor obvious in view of the cited reference, which relates to a full size frame structure and would not even be considered analogous art for purposes of 35 USC 103. Applicants intend to argue this and the structural limitations of the dependent claims, especially claims 3-7, in their brief on appeal. The examiner also appears to be disregarding that claim 12 is directed to a kit which includes panels with different designs for use with a single frame, the panels being interchangeable.

It is believed that no additional fees are due. If this is incorrect, please charge any additional fees to deposit account 50-1588. Applicant has made an earnest effort to place the case in condition for allowance. Favorable action and passage of the case to issue are respectfully requested.

Respectfully submitted,

  
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